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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,032	12/06/2000	Bryan Paul Morgan	WN/KH/JJ/WCM	7516

7590 05/13/2002
Young & Thompson
Second Floor
745 South 23rd Street
Arlington, VA 22202

EXAMINER

GUNTER, DAVID R

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 05/13/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,032

Applicant(s)

MORGAN ET AL.

Examiner

David Gunter

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Traversal

Applicant's election with traverse of claim 18 in Paper No. 10 dated March 28, 2002 is acknowledged. The traversal is on the grounds that claim 18, drawn to a DNA sequence encoding the DAF gene should be examined with claims 23-24, drawn to the DAF protein. The traversal is based on two points: First, that "the outstanding Official Action did not contend that Group VII [claim claims 23-24] is patentably distinct relative to Group IV [claim 18]." Second, that "any complete search for the subject matter of claim 18 would necessarily also involve searching for the subject matter of claims 23 and 24...."

These arguments are not found persuasive. In regard to the first argument, the examiner calls the applicant's attention to page 5 of the restriction requirement (paper number 9, dated 2/28/02) in which the examiner states "Groups III or IV and VI or VII are patentably distinct because DNA can be used as a probe while the protein can be used to isolate antibodies." In regard to the second argument, nucleotide sequences encoding proteins are structurally and functionally distinct chemical compounds from the amino acid sequences they encode, and so are unrelated to the protein. The nucleotide and the protein encoded are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121.

The requirement is still deemed proper and is therefore made FINAL.

Restrictions

This application contains claims directed to three patentably distinct sequences:

1. a DNA sequence that encodes the amino acid sequence specified in SEQ ID NO 17, a putative porcine homolog of DAF
2. a DNA sequence that encodes the amino acid sequence specified in SEQ ID NO 18, a second putative porcine homolog of DAF
3. a DNA sequence that encodes the amino acid sequence specified in SEQ ID NO 19, human DAF

Nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141.

Therefore, under 35 U.S.C. 121, the following restriction is considered proper: The applicant must select a single amino acid sequence from SEQ ID NOs: 17-19 and claim the DNA molecule which encodes the designated sequence. Applicant should note that although the restriction requirement is based on the selection of an amino acid sequence, it is the corresponding nucleotide sequence that will be prosecuted on its merits, according to the elected claim 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Gunter whose telephone number is (703) 308-1701. The examiner can normally be reached on 9:00 - 5:00 M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9212 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.



David R. Gunter, DVM PhD
May 6, 2002

